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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,656	09/03/2004	Hans Lautenschlager	WAS0653PUSA	4812

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EXAMINER
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ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/506,656

Applicant(s)

LAUTENSCHLAGER ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-25 is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☒ Claim(s) 13-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17:2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/03/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Objections***

Claims 13-18 are objected for their very awkward presentation. First of all, the claim is phrased using the unusual <sup>Jepson</sup>~~Jepson~~ format (as reflected by the expression "the improvement comprising") where it doesn't seem to be justified here. Further, as the claim is constructed, it is difficult to ascertain what Applicant regards as the essential steps of their process. As the claim is written, the only essential step is that of "selecting" a material wherein it is implied that the material is added to a crosslinkable silicone composition that is, in turn, coated onto a substrate. However, it is noted that the latter two steps are not expressly stated. Substantial revision of the claim is recommended. Applicant might consider stating the process as, "a process for reducing the formation of aerosol in a crosslinkable silicone composition..."

For the purpose of evaluating the claim against the prior art, it has been assumed that the process is to entail at least (i) adding the organosilicon compound to a crosslinkable silicone coating composition and (ii) spray-coating the composition onto a substrate.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13 is defined a variable "x" for which there is no antecedent basis in the formulae preceding the definition. It is noted, on the other hand, that this variable appears in claim 17 in the description of the starting material (1) from which the antimisting compound is derived by way of its reaction with a hydrosilyl group-terminated linear polydiorganosiloxane.

Likewise, in claim 17, there is no antecedent basis for the mention of R'. Furthermore, a variable R<sup>1</sup> is defined but does not appear in any of the formulae outlined in claim 17.

### ***Claim Analysis***

It is noted for the record that the process disclosed in claim 17 employs a significantly wider number of possible compounds as the antimisting agent than does the process of claim 13. Indeed, claim 13 recites a polymer that would have been derived from at least one compound (1) in formula 17 where "x" and "z" in radical C are equal to one. There is no such requirement in claim 17 and, thus, the polymer may contain only radicals C where "x" and "z" are zero or, alternatively, radicals C where one of x and z are one and the other is zero, or a combination of these scenarios.

### ***Allowable Subject Matter***

Claims 13-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claims 19-25 are allowable. The one requirement that all of these claims share in common is that the organosilicon compound, a branched siloxane/silalkylene copolymer, is added to a crosslinkable composition. Herzig et al., U.S. Patent # 5,760,145 represents the

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most germane prior art because it describes polymer materials having the structural features belonging to the claimed antimisting additive. This reference fails to anticipate the claims however because the equivalent compound is not being added to a crosslinkable composition. Rather, it constitutes one in a pair of materials that, together, are crosslinkable. That is to say, components (B), (C), and (D) of the composition taught by Herzig do not, by themselves, represent a crosslinkable composition. (The Examiner considered whether or not the composition could potentially crosslink by dehydrogenation-condensation but it doesn't seem that (C) would promote that type of reaction.)

The number of references even mentioning branched siloxane/silalkylene copolymers appears to be fairly limited. Dvornic discloses in column 5 a reaction between 1,2-divinyl-tetramethydisiloxane and a compound adhering to formula (1) in claim 17 where  $z = 0$  and  $x = 1$  but there is no suggestion to add the product of this reaction to a crosslinkable silicone composition. Dow Corning owns a number of patents describing dendrimeric carbosiloxanes that have polymerizable groups for introducing the dendrimer framework as side chains in a vinyl polymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 12, 2005

Marc Zimmer  
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AU 1712